

FILED ELECTRONICALLY

PATENT APPLICATION
Docket No. 14531.71.4.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:)	
	John J. Daniels)	
Serial No.:	09/993,780)	
Filed:	November 16, 2001)	Art Unit
For:	REMOTELY CONTROLLING A VIDEO RECORDER)	2621
Examiner:	Y. Young Lee)	
Customer No.:	47973)	

REPLY BRIEF FOR APPELLANT

VIA eFILE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

An Examiner's Answer was mailed in this case on November 25, 2008. This reply brief is being timely filed on January 23, 2009 in response to the Examiner's Answer, under the provisions of 37 C.F.R. § 41.41.

INTRODUCTION

In its appeal brief, appellant demonstrated that in neither Schein nor Klosterman are recording instructions provided to a recording device *from a server, in response to* the selection of a television program from a programming schedule, as the independent claims require. The Examiner's Answer fails to rebut this critical fact. Instead, the Examiner points to recording instructions that are provided to a recording device, but not from a server. And the Examiner points to a server that provides a programming schedule, but does not provide recording instructions in response to a selection from the programming schedule. Moreover, the Examiner does not point to any reason why a person of ordinary skill would have modified Schein or Klosterman to function in the manner claimed in the independent claims. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Nor does the Examiner have any answer to the real-world facts, which show that the Schein inventors included one of the Klosterman inventors (indeed, Mr. Klosterman himself)—and therefore had full access to the Klosterman disclosure. Yet the Schein inventors did not conceive of modifying Klosterman so as to arrive at the claimed methods. These real-world facts are not even addressed, let alone rebutted, by the Examiner.

The Examiner has also failed to point to any disclosure that would have rendered the other groups of claims obvious. The Examiner's rejections should be reversed.

ARGUMENT

- I. The Examiner Has Not Established A *Prima Facie* Case of Obviousness For Any Claim
 - A. *The Examiner Has Not Established A Prima Facie Case of Obviousness For Claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80 Because The Combination Relied On By The Examiner Does Not Disclose The Requesting/Sending of Recording Instructions From A Server In Response To The Selection of a Television Program*

In response to appellant's brief, the Examiner begins with the assertion that "both Figures 10 and 11 of Schein et al and Figure 2 of Klosterman illustrate the concept of...well known TV guides containing recording instructions (e.g. channel, start time, duration, etc) provided from the server." (Ex. Answer at 7). The Examiner then further asserts: "In response to the selection of a program to be recorded by the user, the recording system...then carries out an automatic switching/tuning such that the required program source is input to the destination device, and the tuner is tuned to the selected program's channel." (Ex. Answer at 7). The Examiner seems to be missing the point; even if all of this is true, it is insufficient to meet the limitations of the claims. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

It is insufficient that Schein and Klosterman (1) may disclose "well known TV guides" containing "channel, start time, [and] duration" information "provided from [a] server," (2) may disclose that a user can select a program from the "TV guide," and (3) may disclose that the program will then be recorded in response to that selection. Claim 37 requires that the user's selection from the "TV guide" must be "receiv[ed], at the server" and further requires that "in response to the particular television program being selected for recording," "the server" must transmit "recording instructions that are configured to cause the recording apparatus to record the particular television program." Similarly, claim 44 requires that a request "for the selected and particular television program to be recorded" must be sent "to the server" and that "recording instructions" must be received "directly in response to the request for the particular television

program to be recorded.” There is no disclosure or suggestion in Schein or Klosterman that the user’s selection to record a television program shown in a “TV guide” should then be sent to the server that sent the “TV guide,” nor that anything (let alone “recording instructions”) be sent from the server in response to that selection. To the contrary, Schein and Klosterman teach recording the selected television show without any further interaction with the server.

The Examiner next argues that “one of ordinary skill in the art would have recognized that the present invention is merely a VCR programming method applied through the internet as opposed to the conventional broadcast or Cable TV Company.” (Ex. Answer at 7). This statement is difficult to understand, because it appears to be advancing an irrelevant proposition. It is irrelevant to the obviousness inquiry whether “one of ordinary skill in the art would have recognized that the present invention is merely a VCR programming method applied through the internet.” This is because an obviousness inquiry does not ask how one of ordinary skill in the art looking at the “present invention” would have characterized it, but whether a person of ordinary skill in the art, *looking at the prior art* at the time of the invention, would have found the claimed invention to be obvious. Indeed, Schein also discloses “a VCR programming method applied through the internet,” but it is different from the claimed method. The Examiner has not explained why the differences are such that the claimed method would have been obvious and thus has failed to establish a *prima facie* case.

Acknowledging that the claims require two separate requests of the server, the Examiner next attempts to set forth a theory as to how Schein discloses two server requests. The Examiner asserts that there is a “first request” to the server when a user requests permission to log in to a website. (Ex. Answer at 7). The Examiner asserts that there is a “second request” when the user selects a program to record. (Ex. Answer at 8). The problem with this analysis is that this

“second request” in Schein and Klosterman is not a request *to the server*, as the claims require. In Schein and Klosterman, it is only a request to the local recording system, which handles recording completely locally.

The Examiner next attempts to minimize this claim requirement by asserting that “such requests are merely mouse clicks or the user pushing the enter key on his/her keyboard.” (Ex. Answer at 8). But once again, the examiner is relying on an irrelevant assertion. It does not matter how simple it is for the user to initiate a server request when the claimed method is carried out; the question is whether it would have been obvious to make the server request in the first place. Neither Schein nor Klosterman provides any suggestion to do so; indeed, they teach away from doing so because they disclose making a *local* request for recording parameters that have already been provided and stored. The Examiner does not explain why a person of ordinary skill would modify Schein or Klosterman to implement a method that initiates a request for recording information from the server, when the local recording system in Schein and Klosterman has *already* obtained that recording information. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Nor does the Examiner provide any rebuttal to the real-world facts, which show that the Schein inventors included one of the Klosterman inventors (indeed, Mr. Klosterman himself). The face of the patents also show that both set of inventors assigned their patent rights to a company named “Starsight Telecast Incorporated,” in Fremont, California, suggesting that the inventors all worked for this same company. Despite the fact that the Schein inventors had full access to the Klosterman disclosure, the Schein inventors did not conceive of modifying the Klosterman disclosure (or their own disclosure) so as to arrive at the claimed methods. These real-world facts are not even addressed, let alone rebutted, by the Examiner.

For all of the foregoing reasons and for the reasons set forth in appellant's opening brief, the Examiner's decision should be reversed in its entirety.

B. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claims 3-7, 37, 39, 40, 45-46, 64-76, and 78-80 Because The Examiner Has Not Pointed To Any Disclosure of Recording Instructions That Include A Record Command

Even if the Examiner has established a *prima facie* case of obviousness for the other claims, he has not done so for claims 3-7, 37, 39, 40, 45-46, 64-76, and 78-80. These claims (via dependencies on claims 37 and 45) all require that the "recording control information" or the "recording instructions" include a "record command." Claim 37 also requires that the "record command" be stored "at the server." The Examiner's only response is to invoke the "broadest reasonable construction" rule, asserting that "the start time, duration, and channel number of the program to be recorded may be viewed as recording commands in their broadest reasonable sense." (Ex. Answer at 8).

The "broadest reasonable construction" rule, however, does not free the Examiner from the plain language of the terms nor from the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) ("The Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'"). Here, the term is a "record *command*." A "start time, duration, and channel number" do not constitute a "command." Moreover, the specification expressly distinguishes a "record command" from "time, channel and duration information." (Specification at ¶¶ 138, 142). Specifically, the Specification states: "The stored **television programming information** includes descriptive data such as the show description, date, **time, channel and duration information** (step one). The **function command data** or

VCR control information is stored on a server including functions such as a record command, remind command, repeat command (step two). Access is provided to the *television program information* and the *function command information* from a network, such as the Internet (step four).” (Specification at ¶ 142). The above-quoted passage makes clear that “time, channel and duration information” fall under the category of “television programming information,” whereas a “record command” falls under the category of “function command information.” The passage then makes clear that the two categories are different, because it refers to “the television program information *and* the function command information.” Thus, the Examiner’s interpretation of “record command” as including “start time, duration, and channel number” is not a reasonable interpretation of “record command”; it is flatly inconsistent with the usage of that term in the specification. *See In re Buszard*, 504 F.3d 1364 (Fed. Cir. 2007) (holding that Examiner’s interpretation was too broad to be reasonable when viewed in light of the specification). Thus, even if the Examiner has established a *prima facie* case of obviousness for the other claims, he has not done so for claims 3-7, 37, 39, 40, 45-46, 64-76, and 78-80.

C. *The Examiner Has Not Established A Prima Facie Case of Obviousness For Claims 69-72 Because The Combination Relied On By The Examiner Does Not Disclose That Programming Information Is Made Available Based On A Caller ID, Area Code, Or Phone Number*

Even if the Examiner has established a *prima facie* case of obviousness for the other claims, he has not done so for claims 69-72. Claim 69 requires making programming information available to the user based on the user’s caller ID, area code, or phone number, or any combination thereof. Claim 70 requires making appropriate programming information available based on the locality of a user’s modem. Claim 71 requires making appropriate programming information available based on a caller ID associated with the user’s modem.

Claim 72 requires making programming information available to the user based on a phone number of the user.

The Examiner argues as follows: “one of ordinary skill in the art would have had no difficulty in recognizing that the cable system 510 of Schein et al is *inherently* dependent on the user’s area code (e.g., through cable modem 518). That is, only programming information of his/her local cable provider would be available, based on his/her cable subscription.” (Ex. Answer at 9 (emphasis added)). The Examiner’s first sentence seems to be arguing that a cable system must inherently (*i.e.*, necessarily) know a user’s “area code” in order to provide cable service to that user. The Examiner provides no support for this assertion of inherency, and it does not seem to be correct. The Examiner’s second sentence seems to be arguing that a cable service inherently makes programming information available to a user based on the location of that cable service. But even if this were true, this does not satisfy the claims. The claims require that programming information be made available “based on the user’s caller ID, area code, or phone number,” or “based on the locality of a user’s modem,” or “based on a caller ID associated with the user’s modem,” or “based on a phone number of the user,” not “based on the location of the cable service.” Thus, the Examiner has failed to establish a *prima facie* case of obviousness as to claims 69-72.

D. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claims 73 and 79 Because The Examiner Has Not Pointed To Any Disclosure Of The Transmission Of An End-Of VCR Control Information or About-to-Send VCR Control Information

Even if the Examiner has established a *prima facie* case of obviousness for the other claims, he has not done so for claims 73 and 79. Claim 73 requires “subsequent to downloading recording instructions, the server transmits data comprising an end-of VCR control information to the computing system.” Claim 79 requires “the server sending data comprising about to send

VCR control information prior to actually transmitting the recording control information.” This is disclosed in Figure 10 and paragraph 135 of the specification.

The Examiner apparently points to Figure 4 of Klosterman as disclosing these limitations. (Ex. Answer at 6). However, Figure 4 merely discloses a command generated by the local control system to start VCR recording or to stop VCR recording. In contrast, the specification makes clear that “end-of VCR control information” is not a command which stops VCR recording. Rather, it is a marker or a flag in a transmission stream that indicates that transmission of all of the VCR control information has been completed. (Specification at ¶ 135). Similarly, the specification makes clear that “about to send VCR control information” is not a command which starts VCR recording. Rather, it is a marker or a flag in a transmission stream that indicates that VCR control information will follow. (Specification at ¶ 135).

The Examiner responds by stating that “the features upon which applicant relies...are not recited in the rejected claims.” (Ex. Answer at 9). Thus, the dispute here appears to be a dispute over the interpretation of the terms in the claims. The Examiner acknowledges that “the claims are interpreted in light of the specification,” but asserts that the applicant’s interpretation reads limitations from the specification into the claims. (Ex. Answer at 9). Appellant respectfully submits that the broadest reasonable construction of the claim term “end of VCR control information,” when read in light of the specification, does not encompass a command that stops VCR recording. Similarly, the broadest reasonable construction of the term “about to send VCR control information,” when read in light of the specification, does not encompass a command that starts VCR recording.

Paragraph 135 of the specification discusses the two claim terms and reads as follows:

[0135] Figure 10 is a flow chart illustrating the steps of receiving VCR control information (Figure 7, step two). The user receives an *about-to-send VCR control*

information data from the network server (step one). The user's apparatus (digital television, computer, set top box, etc.) containing the inventive device is then operated so that [it] is prepared to receive and store VCR control information (step two). The VCR control information is then received (step three) and after the reception has been completed, an ***end-of VCR control information*** data is received (step four) from the network server. Thus, the user's apparatus is operated so that it can effectively receive the VCR control information.

Paragraph 139 of the specification, in contrast, discusses the starting of VCR recording:

[0139] Figure 14 is a flow chart of the step of generating the universal remote control signals effective to control a VCR to record a program (Figure 7, step six). The ***universal remote control signals*** are generated (in the manner of the well known universal remote controllers) as necessary to control the recording apparatus or digital appliance (VCR, set top box, computer or television) to tune in the correct channel and ***to control the VCR to begin recording the selected program*** (step one). The received television signal is recorded from the selected channel for a time depending on the duration information contained in the VCR control information (step two).

Thus, the specification makes clear that the "remote control signals" that "control the VCR to begin recording" are different from "end of VCR control information." The Examiner's interpretations of "end of VCR control information" and "about to send VCR control information" are unreasonable, especially when viewed in light of the specification. Because neither Schein nor Klosterman discloses "end of VCR control information" or "about to send VCR control information," as those terms are properly construed, the Examiner has failed to establish a *prima facie* case of obviousness as to claims 73 or 79.

E. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claim 75 Because The Examiner Has Not Pointed To Any Disclosure Of a Binary ASCII-format Character String That Is Assigned Specific Control Functions

Even if the Examiner has established a *prima facie* case of obviousness for the other claims, he has not done so for claim 75. Claim 75 requires that recording instructions embedded in and received with television programs are received as "a binary ASCII-format character string that is assigned specific control functions."

The Examiner responds by asserting that “ASCII is built into all personal computers. Therefore, one of ordinary skill in the art would have had no difficulty in recognizing that the PC TV of Schein et al would *inherently* utilize ASCII-format character strings for control functions.” (Ex. Answer at 9 (emphasis added)). The Examiner’s argument of inherency is flawed. Although it is true that ASCII is built into most personal computers, other communications protocols and formats are also built into personal computers. Thus, the fact that a computer is being used does not inherently mean that ASCII-format character strings will be used for any given function, let alone for specific control functions. Nor does it mean that such character strings will be “embedded in and received with the television signal,” as claim 75 requires (from its dependency on claim 68). The Examiner has failed to establish a *prima facie* case of obviousness as to claim 75.

CONCLUSION

For the foregoing reasons, Appellant respectfully requests that the Board reverse the Examiner’s rejections of the appealed claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80.

Dated this 23rd day of January 2009.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
DAVID R. TODD
Registration No. 41,348
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant
Customer No. 47973